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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,783	10/29/2003	Richard Warby	WARB3001/REF	6091
23364	7590	09/20/2006	EXAMINER	
BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314			DRODGE, JOSEPH W	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,783

Applicant(s)

WARBY, RICHARD

Examiner

Joseph W. Drodge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 36,37,42 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by DeCrosta et al (hereafter referred to as DeCrosta) patent 5,550,211. DeCrosta discloses a method of cleaning/purifying elastomeric and rubber polymers for articles for medical and pharmaceutical use including contacting the articles with aliphatic alcohols and consequently discloses the corresponding apparatus/articles and method of making the claimed articles. This encompasses: preparation of (forming of) gaskets (i.e. seals) and valves employed in manufactured pharmaceutical dispensing devices (column 1, lines 13-23 and column 2, lines 28-32); providing an elastomeric composition that may be a butyl rubber or include isobutyl materials (column 3, lines 1-6 and column 5, lines 17-22); initiating a cross-linking reaction (column 3, lines 5-10), and contacting the gasket or seal with an alcohol solvent to remove impurities by extraction (column 4, lines 14-18, 33-35, 45-47, impurities removed include residual cross-linking agents (column 3, lines 5-6), waxes (column 5, lines 24-26) and accelerators/process aids (column 1, lines 24-27). The instant claims do not preclude the solvent being applied as a supercritical fluid as disclosed by DeCrosta. For claims 37,40,43 and 46 the alcohol may be ethanol (column 4, line 46).

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 39,40,45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeCrosta in view of Thomas patent 6,234,362. Impurities removed in DeCrosta include residual cross-linking agents (column 3, lines 5-6), waxes (column 5,

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lines 24-26) and accelerators/process aids (column 1, lines 24-27) used in product manufacturing.

Claims 39,40,45 and 46 differ in requiring the elastomeric rubber polymer to be isobutylene or co-polymer thereof. Thomas teaches such at column 1, lines 44-54. It would have been obvious to one of ordinary skill in the art to have selected isobutylene or copolymer as the elastomer used in DeCrosta in view of the superior sealing properties and extended shelf life of products comprising isobutylene.

Claims 38 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeCrosta in view of Cripps or newly cited Adjei et al (Adjei) patent 6,596,261.

Claims 38 and 44 differ from DeCrosta in requiring a compression or injection moulding step in the manufacture of the seal. However, Cripps teaches moulding at paragraph 134, as does Adjei at column 10, lines 42-62. It would have also been obvious to employ moulding in the manufacture of the DeCrosta seals, to enable efficient manufacture of the articles and to allow use of fewer components in the finished articles, by producing integrally combined components.

Claims 41 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeCrosta in view of Thomas patent 6,234,362 as applied to claims 39 and 45 above, and further in view of Adjei or Cripps. Claims 38 and 44 differ from DeCrosta in requiring a compression or injection moulding step in the manufacture of the seal. However, Cripps teaches moulding at paragraph 134, as does Adjei at column 10, lines 42-62. It would have also been obvious to employ moulding in the manufacture of the

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DeCrosta seals, to enable efficient manufacture of the articles and to allow use of fewer components in the finished articles, by producing integrally combined components.

Applicant's arguments filed on July 29, 2006 have been fully considered but they are not persuasive. It is argued that since claim 33 was not treated in the previous Office Action it must then be allowable. However, it is submitted that treatment of claim 33 was overlooked by examiner oversight and is rejectable largely over the applied prior art of record. Claims 31-33 which contain most of the limitations of the newly filed claims were indicated as rejected over prior art.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Drodge at telephone number 571-272-1140. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at 571-272-1151. The fax phone number for the examining group where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or Public PAIR, and through Private PAIR only for unpublished applications. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD

August 7, 2006


JOSEPH DRODGE
PRIMARY EXAMINER